

ATTORNEY DOCKET NO. 06027.0001U3
Application No. 10/042,991

REMARKS

Applicants would like to respectfully point out that the inventors are incorrectly listed on the Filing Receipt for the present application as Ian Michael Whitehead, Alan John Slusarenko, Urs Wäspi, Duncan James Horatio Gaskins, Alan Ricard Brash and Nathalie Tijet. The inventors of the invention being claimed in this application, and as correctly set forth in the Continuation Application Transmittal Form filed on January 9, 2002, are Ian Michael Whitehead, Alan John Slusarenko, Duncan James Horatio Gaskins, Alan Ricard Brash and Nathalie Tijet. Therefore, Urs Wäspi should not be listed as an inventor. Applicants respectfully request that the correct inventorship for this application be noted.

Claims 1-21 are pending in this application. Claims 16-21 are cancelled herein without prejudice in an effort to facilitate prosecution.

Although applicants believe that one of skill in the art would readily recognize that the term "fatty acid 13-hydroperoxide lyase" encompasses enzymatic activity, claims 1-3 are amended herein, as suggested by the Examiner, to recite that the recombinant protein has fatty acid 13-hydroperoxide lyase activity. Support for these amendments can be found in claims 1-3 as filed, on page 7, lines 18-21 of the specification and elsewhere throughout the specification. No new matter is believed to be added by these amendments. Thus, applicants respectfully request entry of the claim amendments, reconsideration of this application and allowance of the pending claims to issue.

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II. Rejection Under 35 U.S.C. § 112, second paragraph

A. The Office Action states that claims 1-15 and 16-21 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter with applicant regards as the invention. Specifically, the Office Action states that claims 1-15 and 16-21 are indefinite in the recitation of "fatty acid 13-hydroperoxide lyase" as the specification defines a "fatty acid 13-hydroperoxide lyase" as a lyase protein having at least one function exhibited by native 13-hydroperoxide lyase, including catalytic activity as well as antigenic activity. According to the Office Action, the definition of what applicants consider to be encompassed by the term "fatty acid 13-hydroperoxide lyase" is allegedly contrary to that which one of skill in the art would consider to be encompassed by the term. Further stated in the Office Action is that the ordinary artisan would consider a "fatty acid 13-hydroperoxide lyase" to have at the minimum enzymatic or catalytic activity, which as defined by the specification is allegedly not essential for the described protein, only an option.

As stated above, applicants believe that one of skill in the art would understand the term "fatty acid 13-hydroperoxide lyase" to encompass enzymatic activity, as intended by applicants. However, as suggested by the Examiner, and in order to advance prosecution, claims 1-3 are amended herein to recite that the recombinant protein has fatty acid 13-hydroperoxide lyase activity and claims 16-18 are cancelled. Thus, applicants believe this rejection has been overcome and respectfully request its withdrawal.

B. The Office Action states that claims 16-18 are indefinite in the recitation of "stringent conditions hybridization conditions" as the specification allegedly does not define what

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conditions constitute "stringent." Claims 16-18 are cancelled herein without prejudice. Therefore, applicants believe this rejection has been overcome and respectfully request its withdrawal.

III. Rejections Under 35 U.S.C. § 112, first paragraph

The Office Action states that claims 1-3 are rejected under 35 U.S.C § 112, first paragraph, as containing subject matter which was allegedly not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants believe that the amendments of the claims and the arguments as set forth above overcome this rejection.

The Office Action further states that claims 16-21 are rejected under 35 U.S.C. § 112, first paragraph because the specification while being enabling for those claimed methods of use of a 13-hydroperoxide lyase enzyme wherein said polypeptide comprises the amino acid sequence of SEQ ID NOs: 2, 3, 4 or 6, allegedly does not reasonably provide enablement for those claimed methods of use of a 13-hydroperoxide lyase enzyme encoded by a nucleic acid, wherein said nucleic acid specifically hybridizes with the nucleic acid of SEQ ID NO: 7 under stringent conditions and does not hybridize under stringent conditions to the nucleic acid set forth in SEQ ID NO: 11 or SEQ ID NO: 12. Although Applicants would like to point out that an isolated nucleic acid which specifically hybridizes with the nucleic acid of SEQ ID NO:7 under stringent conditions of hybridization and which does not hybridize at the stringent conditions to the nucleic acid set forth in SEQ ID NO:11 or SEQ ID NO:12 was found to be patentable in U.S. Patent No. 6,200,794 B1. Therefore, the currently pending methods of utilizing the nucleic acid

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patented in U.S. Patent No. 6,200,794 B1 should also be patentable. However, in order to advance prosecution, claims 16-21 are cancelled herein and Applicants respectfully request withdrawal of this rejection.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$110.00 for a one (1) month extension of time fee and a Request for Extension of Time are enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

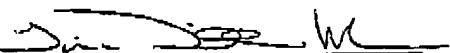


Tina Williams McKeon, J.D., Ph.D.
Registration No. 43,791

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and anything indicated as included is being transmitted via Facsimile No. 703-872-9306 addressed to:
Attn: Examiner Hutson, U.S. Patent and Trademark Office, on the date shown below.



Tina Williams McKeon

29 March 2004
Date